

#10/Supp
Response
2.6.03
C. Moore

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket

VAN LAMMEREN ET AL

PHN 16,019A

Filed: March 28, 2001

Group Art Unit: 2829

Serial No. 09/819,287

Examiner: Vinh P. Nguyen

METHOD AND APPARATUS FOR INSPECTING AN INTEGRATED CIRCUIT BY
MEASURING VOLTAGE ON A SIGNAL LINEHonorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service
with sufficient postage as first-class mail in an envelope
addressed to: ASSISTANT COMMISSIONER FOR PATENTS,
WASHINGTON, DC 20231.

☒ transmitted by facsimile to the United States
Patent and Trademark Office at 703-872-9318.

On:

Jan. 31, 2003

By:

Chessa DeLucy

FAX RECEIVED

SUPPLEMENTAL RESPONSE

JAN 31 2003

Sir:

TECHNOLOGY CENTER 2800

The Terminal Disclaimer reference in the Response faxed
January 21, 2003 failed to include the Terminal Disclaimer
referenced therein.

A Terminal Disclaimer is hereby submitted.

Respectfully submitted,

By



Eric M. Bram, Reg. 37,285
Patent Attorney
(914) 333-9635

s:\br\n\16\n16019a.suppresp

1

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**Docket Number (Optional)
PHN 16, 019A**RECEIVED**

In re Application of: Johannes P.M. Van Lammeren et al

APR 03 2003

Application No. 09/819,287

Filed: March 28, 2001

OFFICE OF THE SPECIAL

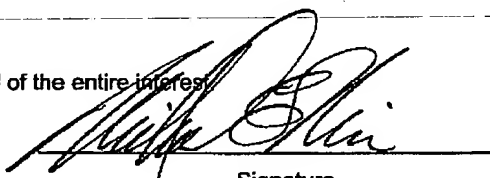
For: METHOD AND APPARATUS FOR INSPECTING AN INTEGRATED CIRCUIT BY MEASURING VOLTAGE ON A SIGNAL LINE

The owner, U.S. Philips Corporation of the entire interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,239,604. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Please charge Deposit Account 14-1270, the terminal disclaimer fee under 37 CFR 1.20(d).

The undersigned is an assignee of record of the entire interest.



Signature

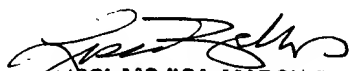
1/27/03
Date

Michael M. Marion

Typed or printed name

U.S. Philips Corp.
Authorized Signatory**TERMINAL DISCLAIMER
DISAPPROVED**

APR 03 2003

**TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER**
LISSI MOJICA MARQUIS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 2800

04/02/2003 DSASFAI 00000002 141270 09819287

01 FC:1814 110.00 CH

s:\br\n16019a.termdisc1

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 04-Apr-03APPL. S.N.: 09/819,287TO: EXAMINER Nguyen, VinhART UNIT: 2829FROM: Hoppe, Sharon

PARALEGAL SPECIALIST

RETURN THIS MEMO TO: CP4-6D34SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 31-Jan-03

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

☐ The T.D. is PROPER and has been recorded (see ¶ 14.23).

☒ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):

☐ The TD fee of has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).

☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶ ¶ 14.26 & 14.26.01).

☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection. Rule 321(b) (see ¶ 14.27.01).

☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶ ¶ 14.26 & 14.26.02).

☒ The person who signed the T.D.:

☒ is not an attorney “of record” (see ¶ ¶ 14.29 and 14.29.01).

☒ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).

☒ is not recognized as an officer of the assignee (see ¶ ¶ 14.29 & possible 14.29.02).

☒ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).

☐ The T.D. is not signed (see ¶ ¶ 14.26 & 14.26.03).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶ ¶ 14.26, 14.27.02 or 14.26.05).

☐ The period disclaimed is incorrect or not specified (see ¶ ¶ 14.26, 14.27.02 or 14.26.03).

☐ Other:

☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

Log Date: _____

DATE:

4/3/03

APPL. S.N.:

09/819,287

TO: EXAMINER:

ART UNIT:

FROM:

Deborah Perry Vega
PARALEGAL SPECIALISTSUBJECT: Decision on Terminal Disclaimer (T.D.) filed:

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